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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/500,203	02/08/2000	Mario S. Tozzi	TOZZI 201	2252
7590	06/20/2005			
Kenneth E Macklin Esq Milde Hoffberg & Macklin LLP 10 Bank Street Suite 460 White Plains, NY 10606			EXAMINER KAZIMI, HANI M	
			ART UNIT 3624	PAPER NUMBER
DATE MAILED: 06/20/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/500,203

Applicant(s)

TOZZI, MARIO S.

Examiner

Hani Kazimi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to Applicant's amendment filed on February 4, 2004. The rejections cited are as stated below:

Response to Applicant's amendment

2. Applicants' amendment filed on February 4, 2004 have been fully considered, and discussed in the next section below or within the following rejections are not deemed to be persuasive. Applicants' request for allowance is respectfully denied.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claim 18 recites the limitation "said identification" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

6. Claim 18 is rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added). Applicant's claim mentioned above is intended to embrace or overlap two different statutory classes of invention as set forth in 35 USC 101. The claim is a method claim and it depends on a system claim (claim 24). "A claim of this type is precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only", Ex parte Lyell (17 USPQ2d 1548).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-10, 17, 18, and 24-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Zampese US Patent No. 6,014,650.

Claims 1-10, 17, 18, and 24-39, Zampese disclose a method and a corresponding system for collecting, storing and forwarding account information and associated account approval information for use with prospective credit or debit transactions

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between terminals and hosts that are parties to said transactions, enabling account withdrawals and charge requests to be initiated by either the accountholder himself or by someone other than the accountholder, using an authorization code as a substitute for said account and the associated account approval information, allowing either said terminal or host involved in said prospective credit or debit transaction to acquire said account and associated account approval information from a non-fiduciary external source, not a party to the transaction and herein called a trigger server, outside of the boundaries of said credit or debit transaction and its associated parties, as if said account and associated account approval information had been supplied to at least one party to said transaction by the accountholder himself; which system (abstract) comprises:

a) an input terminal in which an accountholder provides data indicating an account from where funds could be withdrawn or to where charges could be made, additionally, any associated account approval information required for the effective use of said account, and account use restriction information, if any, comprising the terms and conditions for allowing an external credit or debit transaction to utilize said account, which account use restriction information may include a cap value on the amount of said external credit or debit transaction, all of which are transmitted to (figs. 1 and 2, and column 3, line 64 thru column 4, line 40);

b) a trigger server which stores said account information, as well as said corresponding account approval information along with said account use restriction information, if any, in association with an authorization code known to

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the accountholder, and thereafter delivers said account information and associated account approval information either to said terminal or host involved in said prospective credit or debit transaction in response to a request carrying an authorization code, provided that the verification of said authorization code is successful, and that said prospective external credit or debit transaction complies with said account use restriction information, if any, as set by the accountholder (fig. 1, and column 3, line 29 thru column 4, line 61); and

c) a requesting terminal, set to participate in a prospective credit or debit transaction with a host, which receives an authorization code and personal identification from a presenter, as an alternate payment method for said credit or debit transaction, and transmits said entered authorization code to said trigger server, along with additional information, if any, about said prospective credit or debit transaction, in a request for acquiring said account and associated account approval information from the trigger server, to be used in said prospective credit or debit transaction between said terminal and host, as if said account and associated account approval information had been supplied to said external credit or debit transactions the accountholder himself, and provided that said prospective credit or debit transaction complies with said account use restriction information, if any, as set by the accountholder (fig. 1, and column 3, line 29 thru column 4, line 61).

Zampese teaches that the input terminal includes means for collecting and transmitting said data to said trigger server, comprising at least one of an automated teller machine, a credit or debit card block, a point of sale machine, a personal

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computer, a lotto machine, a touch-tone telephone, a fax machine, and a wireless device (fig. 1), the input terminal generates a random authorization code via keyboard input, and transmits said authorization code which is printed as numbers, letters, symbols, or barcode, or is digitally, magnetically or optically stored to the trigger server for storage and association with said account and account approval information (column 3, line 46 thru column 4, line 61).

Zampese teaches that the account is any account capable of being authorized electronically, including at least one of a credit account, a checking account, a savings account, a money market account, an investment account and a telephone account (fig. 2, and column 3, line 29 thru column 4, line 61).

Zampese teaches that the input terminal is capable of receiving and transmitting additional terms and conditions for the use of said accounts, the server is capable of storing said terms and conditions for the use of the accounts in association with said authorization codes, the additional terms and conditions include at least one of (1) a cap value on the amount of the transaction, (2) dates and times when the use of the account could or could not be permitted, and (3) the identity of payees to which the use of the account is or is not allowed, and the server transmits said account information to said requesting terminal only if said transactions comply with said terms and conditions (figs. 1 and 2, and column 3, line 29 thru column 5, line 39).

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Claim Rejections – 35 U.S.C. 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

11. Claims 11, 12, 14-16, 19, 20, and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zampese US Patent No. 6,014,650.

Claims 11, 12, 14-16, and 19-23, Zampese fails to teach that the accountholder is charged a service charge at the input terminal, and the service charge is imposed at the requesting terminal, and the step of entering via a keyboard a beneficiary account to where money should be remitted electronically, including at least one of a checking account, a money market account, an investment account, and a savings account.

Official Notice is taken that electronic fund transfers between accounts, and charging an account holder a service charge is old and well known in the art.

It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to modify the teachings of Zampese to include the steps of charging the accountholder a service charge at the input terminal, and the service charge is imposed at the requesting terminal, and entering via a keyboard a beneficiary account to where money should be remitted electronically, including at least one of a checking account, a money market account, an investment account, and a savings account because, it greatly improves the efficiency of the system by providing an easier and faster way of submitting payments, and a system that is user friendly.

Response to Arguments

12. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP ' 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

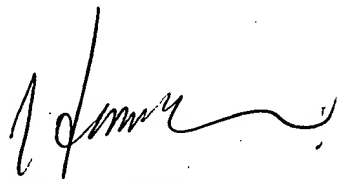
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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (571) 272-6745. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-2 17-9197 (toll-free).



HANI M. KAZIMI
PRIMARY EXAMINER
Art Unit 3624

May 16, 2005